

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

**CHARLES EDWARD GRELLE AND
THE INDEPENDENT FOUNDRY COMPANY,
a Corporation**
APPELLANTS

VS.

**THE CITY OF EUGENE, OREGON,
AND M. F. GRIGGS**
APPELLEES

Appeal from The District Court of The United States
For the District of Oregon

Appellants' Brief

T. J. GEISLER,
Attorney for Appellants

**G. F. SKIPWORTH,
JOHN M. PIPES,
GEO. A. PIPES,**
Attorneys for Appellees

FILED

SEP 12 1914

F. D. MONCKTON,
CLERK.

**United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT**

CHARLES EDWARD GRELLE and THE
INDEPENDENT FOUNDRY COM-
PANY, a Corporation,
Appellants,

vs.

THE CITY OF EUGENE, OREGON,
and M. F. GRIGGS,
Appellees.

*Appeal from the District Court of the United
States for the District of Oregon.*

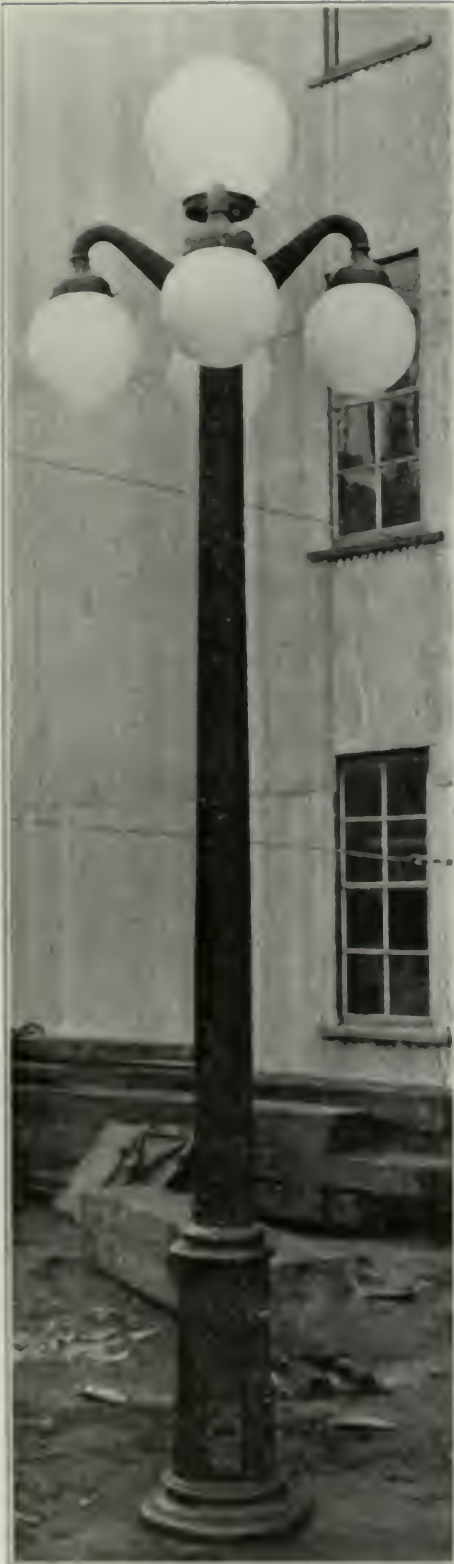
Appellants' Brief

This is an appeal from the final decree of the District Court of the District of Oregon, dismissing a suit brought against the defendants charging infringement of the design patent granted to the above named ^{Charles} Edward E. Grelle, on a lamp post, and under which the appellant Independent Foundry Company holds the exclusive license to manufacture.

The decree of the District Court dismissed the bill for the reason that *while* “*it must be admitted*” that the “comparative drafts of the mere outlines of the two posts” in question “*present great similarity*, and one cannot be readily distinguished from the other without giving particular attention to the details * * * the (defendants’) post runs predominantly in square surfaces while cylindrical surfaces predominate in (plaintiffs), features that must catch the eye instantly and distinguish one from the other.” (Opinion, Trans., pp. 178, 179.) The contention of plaintiffs, however, was that a design “may consist in the simple configuration of a substance or the form given to it as a whole”; in other words, “*the essential characteristics of the appearance imparted to a substance may reside in its exterior outlines only*” (quoting the words of Robinson on Patents, Vol. 1, p. 291, Sec. 204), and the cross section of the thing made after such design could be varied to suit the fancy, without changing the general motive, principle or character of such outline-design.

For convenience of the court, the two designs in controversy are here reproduced, arranged side by side. The outline sketches of these designs are also reproduced.

Front elevation of
Plaintiffs' Post



Plaintiffs' Exhibit "CC"
see page 64, Transcript
of Record

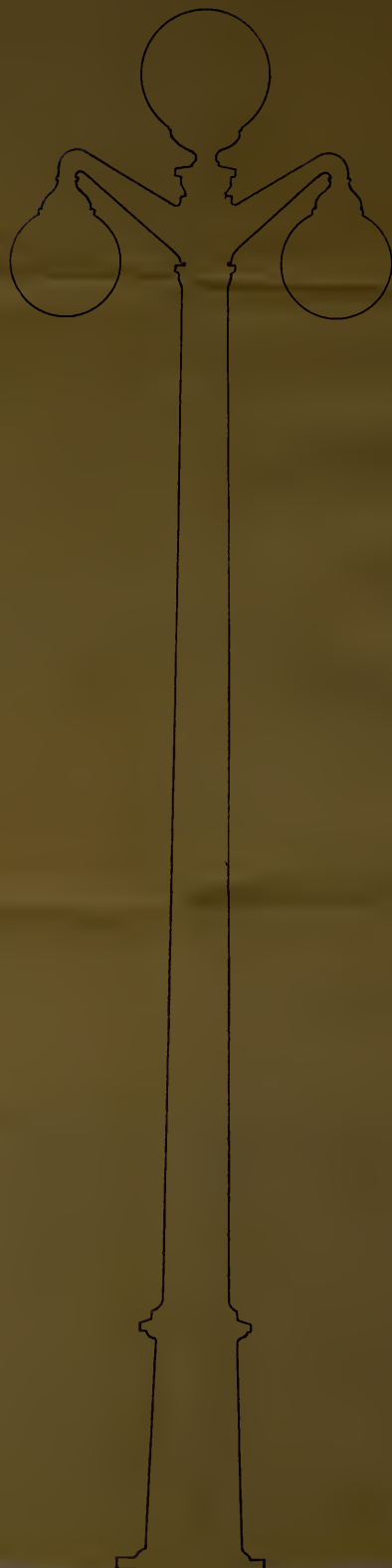
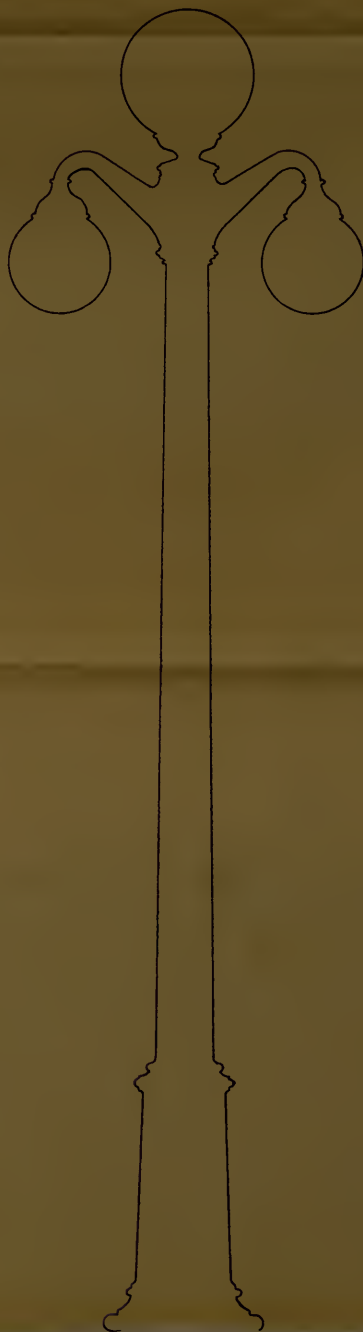
Front elevation of
Defendants' Post



Plaintiffs' Exhibit "AA"
see page 64, Transcript
of Record

Outline sketches of the design patented to C. E. Grelle and manufactured by Plaintiffs, and of the Lamp Post designed by Alvin Meyers, manufactured by Gross Bros. Iron Works for, and installed in the City of Eugene.

PLAINTIFFS' POST



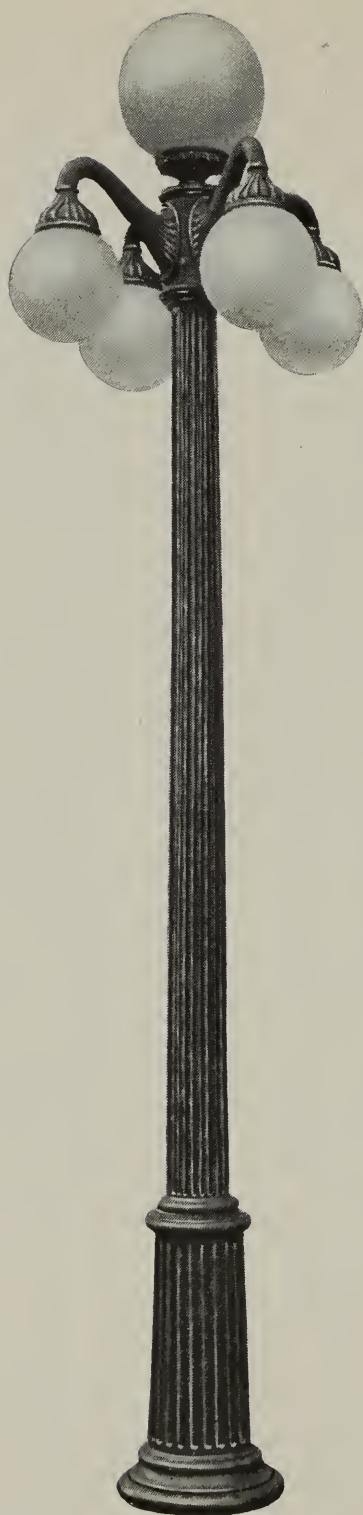


EXHIBIT "A"

A STATEMENT OF THE CASE

Some time prior to October, 1911, C. E. Grelle, Manager and President of the Independent Foundry Company, conceived a new and ornamental design for lamp post. Shortly after Mr. Grelle received a visit from Alvin Meyers, as a representative of the Water Board of Eugene, Oregon. Mr. Meyers was looking for types of lamp posts that said Water Board could install at Eugene. (Transcript, 45.) Grelle submitted such designs as he had for Meyers' consideration, including a sketch of said new design that Grelle had recently developed. This design seemed to appeal particularly to Meyers. (Transcript, p. 131.) This design was later designated by the Independent Company as their type "S" post. (Transcript, p. 46.) Later Grelle also sent a photo of this particular post to Meyers.

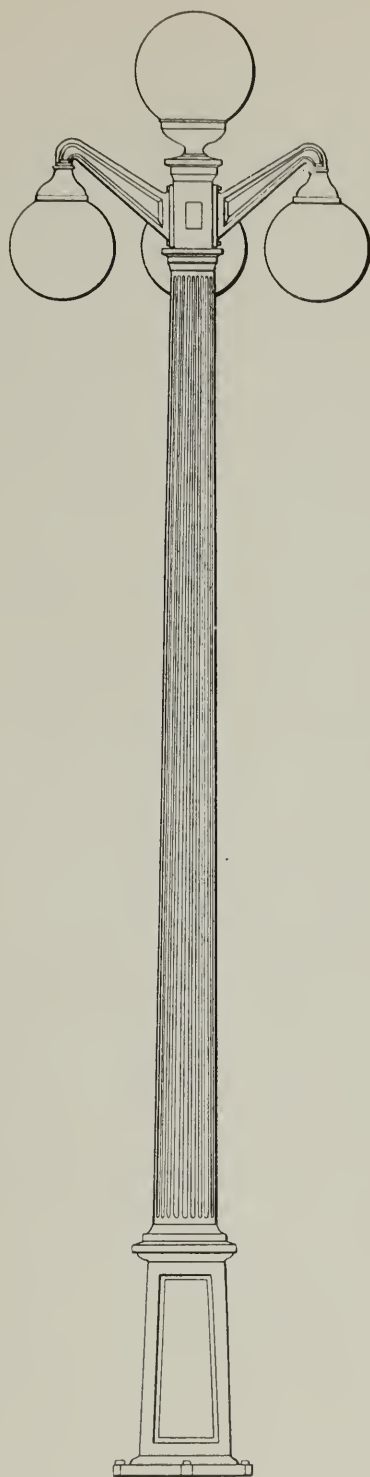
The photo-cut was sent by Grelle to Meyers, in response to a letter written by the latter, October 26, 1911; and on November 27, 1911, the Independent Company sent Meyers a photo of the Grelle lamp post as shown by plaintiffs' exhibit A1, reproduced opposite page 14 of the transcript. The sending of this photo was admitted by defendants. (See Trans., p. 46.) The cut is here reproduced.

On November 28, 1911, Meyers wrote to the Independent Company for quotations on the Grelle post (Transcript, p. 51), with which re-

quest the Independent Company complied by letters dated December 1 and December 9, 1911.

Previous to December 9, 1911, Meyers had drawn the plans of a specification for a post himself, being, as plaintiffs contended, merely a slight modification of the Grelle post, and an estimate of the cost of such modified post was also included in said letter of December 9, of the Independent Company. (Trans., p. 53.)

On December 14, 1911, the Eugene Water Board wrote the Independent Company that they had awarded the contract to a local firm in the City of Eugene. Upon investigation the plaintiffs found that the lamp post adopted by the City of Eugene was the modified design gotten up by Meyers on plaintiffs' said type "S" post. The Independent Company thereupon informed the Eugene Water Board that Grelle had made an application for patent on his design, and that said application had been allowed and the patent would be issued March 6, 1912. (Trans., p. 56.) On March 14, 1912, Grelle, through his attorney, wrote the Mayor and the Water Board of the City of Eugene calling specific attention to the issuance of said patent, enclosing a blue print of the drawing of the patented design, and requested the Mayor and the Water Board to obtain a license from Mr. Grelle to use said design. (Trans., p. 57.) The City of Eugene paid no attention to such letter. They ignored Grelle and the Independent Company entirely, and pro-



TRACING
MADE BY

WM. C. SCHMITT 12-13-'12
of a blue print entitled as
follows,

EUGENE LIGHT DEP'T

STANDARD ORNAMENTAL POST

Scale 1" = 1'

Nov 29, 1911

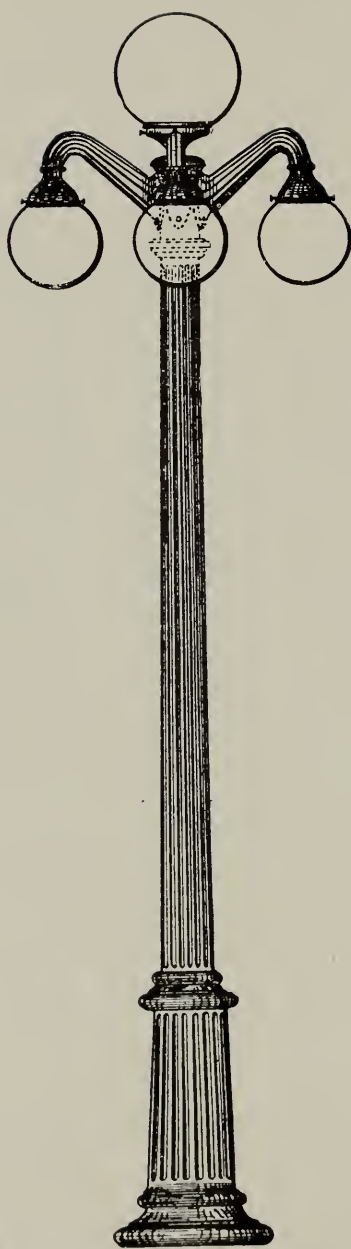


EXHIBIT "A"

ceeded to the manufacture and erection of the lamp post, notwithstanding, and this suit followed.

The Independent Company instituted two suits, one against Gross Bros.' Iron Works of Eugene, and the other against the City of Eugene and M. F. Griggs, which causes were tried together (Trans., p. 175), and by stipulation of the parties the appeals from the decrees in these cases will be heard together, and the disposition of one cause on appeal shall be also that of the other.

The history of the Grelle design patent is as follows:

The application was filed January 2nd, 1902, was passed upon by the Patent Office examiner January 19th, 1912, and was allowed February 16th, 1912. (Trans., p. 58.)

The patent was issued March 12th, 1912, No. 42,283, and constitutes plaintiffs' "Exhibit S." (Trans., p. 59.) The drawing of the design, attached to such patent, is shown on the next page. The claim was in the usual form, reading:

"I claim the ornamental design for lamp post as shown."

In order to show that the outlines, in other words, the motive and principle of the design invented by Grelle and patented to him, and the modification thereof made by Meyers for the

Eugene Water Board, are substantially alike, Mr. Grelle made said outline drawing of these two posts, arranged side by side, constituting plaintiffs' "Exhibit Y." These outline drawings were obtained by scaling the Meyers modified post, plaintiffs' "Exhibit V," being a drawing of the post sent by Meyers to the Independent Company, accompanying his letter of December 7th, 1911 (Trans., p. 61), and drawing on the same sheet and the same scale an outline of the Grelle post. Thus were obtained substantially coincidental views for comparison. (Trans., pp. 62-63.) In order to show, comparatively, the appearance of the Grelle post, *in front elevation*, and the Meyers modified post, plaintiff introduced two photographs; plaintiffs' "Exhibit CC" showing the Grelle patented post design, and plaintiffs' "Exhibit AA" showing the Meyers modified post. These photos are those shown in the introduction of this brief. Plaintiffs also introduced "Exhibit BB," being the photograph of defendants' post from which the cut, plaintiffs' "Exhibit C," attached to the bill, was made, and such perspective view is here reproduced side by side with an angular, or perspective, view of the Grelle patented design lamp post.

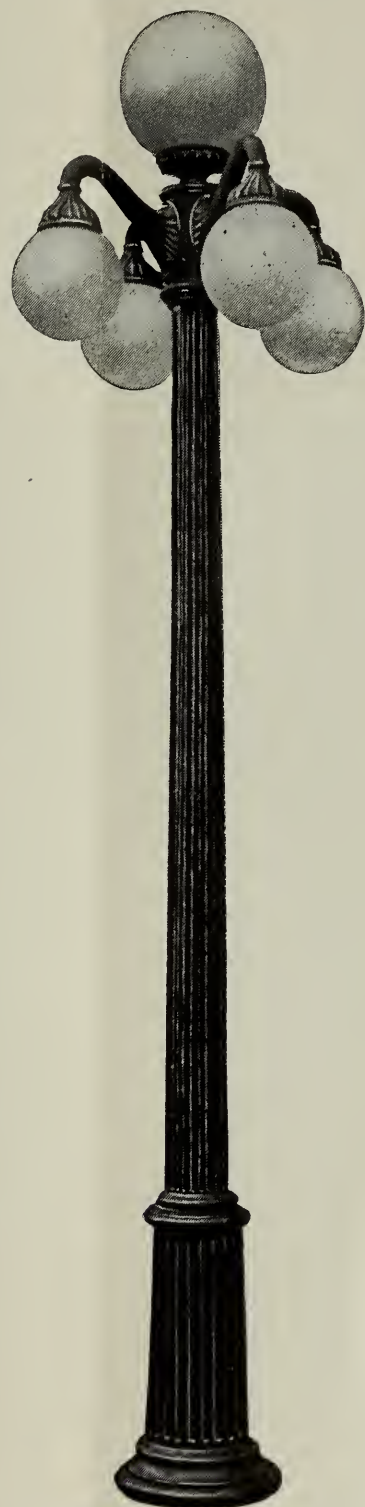
It is, of course, apparent that the defendants' lamp post is made in square cross section, while the Grelle patented design shows a cylindrical post, but Grelle testified (Trans., p. 65) "that a lamp post could be made conforming to the out-

Defendants' Post



Plaintiffs' Exhibit "BB"

Plaintiffs' Post



Plaintiffs' Exhibit "A"

line of his design in round, square or octagonal cross section without changing the outline." This testimony was confirmed by witness Schmitt, who testified as an expert for plaintiffs. (Trans., pp. 79-84.)

The evidence introduced on behalf of defendants may be briefly stated as follows:

Y. D. Hensill was called as an expert by the defendants for the purpose of attempting to prove that the design patented to Grelle was anticipated by the Cutter post, of which an exhibit is given on the page facing page 170 of transcript. The arm of this lamp post was claimed by the witness to be very similar to that of the arm of the Grelle post. The Cutter post, witness testified, was suggestive of the classic type (Trans., p. 93), but he admitted there was little suggesting the classic in the Grelle arm. In fact the testimony of the witness on this point, on his cross-examination (Trans., p. 94), was as follows:

Q. Well, you say there is a little similarity; now where is that little similarity to be found?

A. In a shape of the console from the point it leaves the head here, to the socket here, in the shape.

Q. In the mere fact that it is making a little curve there?

A. It has that irregular curve and drop similar to this.

Q. That resemblance is a very slight one to the classic production of an arm such as I referred to a moment ago, is it not?

A. Very slight.

Q. It is an incomplete one?

A. The comparison is slight.

The same witness being questioned as to the similarity between the Grelle post and the defendants' post, testified (Trans., p. 95):

Q. Now, then, the fact is, however, Mr. Hensill, that the plaintiffs' type of post as an outline is suggestive of the defendants' outline of post, is it not?

A. Merely in the outline.

This witness further testified that a post developed from a given outline might be varied as desired, with regard to cross section, without changing the outline, his testimony on this point being (Trans., p. 90):

Q. Now is it not a fact, with a given outline, I could say to you, Mr. Hensill, "I want that reproduced in square, or in octagonal, hexagon, circular or elliptical, and you could design a lamp post to be manufactured from that outline in each case?"

A. Yes.

The plaintiffs did not claim anything for the base, or the column of the Grelle lamp post; these are merely necessary accessories, and as to

these parts "all lamp posts have to resemble each other to a considerable extent." The difference in the posts being in the top, or head, as testified also by witness Hensill (Trans., p. 87).

The defendants further called as an expert witness A. E. Doyle, a well known architect of Portland, Oregon. Upon being shown the photographs of the two posts for comparison, he testified (Trans., p. 96):

Q. Which is the best one?

A. This large one (referring to plaintiffs' post). "*The other* (referring to the defendants' post) *looks like a poor imitation.*"

Q. You say plaintiffs' post is the best design?

A. Yes, I should say so, decidedly.

Q. That is from an artistic standpoint?

A. From an artistic standpoint, decidedly.

Upon being asked whether the defendants' posts were similar to that of the Grelle posts, he said, "there is a similarity." (Trans., p. 97.)

When cross-examined as to the similarity of the outlines, this witness testified (page 100):

"Yes, of course, they look very similar in outline."

With regard to the novelty of the Grelle post, this witness testified:

Q. Is there anything new or novel in the combination of plaintiffs' post?

A. Oh, I suppose that is a question where you draw the line as to what is new or novel. They are new combinations—there are combinations that I have never seen before. (Page 99.)

This witness admitted that the distinction he drew between the defendants' post and the Grelle patented design was "differences in details." (Page 100.)

Defendants further called as a witness Alvin Meyers, who testified that he was superintendent of the Eugene Water Board in 1911 (page 112). He is a graduate electrical engineer. On cross-examination this witness admitted (page 125) that he received a sketch from Mr. Grelle on his type "S" post, and that it suggested generally the post as finally designed by Mr. Grelle. This witness, however, disputed (pages 125 and 126) the similarity in the outlines of his modified post and the Grelle post:

Q. You listened to the testimony here by Mr. Hensill, and Mr. Doyle. Do you differ from them in the regard to the outlines of the two, disregarding ornamentation and details, exterior details, being the same, that is to say, when comparing the plaintiffs' post and the defendants' post as shown on the drawing here before you? (Referring to plaintiffs' exhibit Y, being said outline cut.)

A. I don't consider that this is a fair outline of their post. (Page 126.)

Q. Well, assuming that to be a fair outline, do you agree with them or differ, that, admitting that the plaintiffs' sketch was the prior in point of time, in that case it was directly suggestive of the defendants' outline?

A. I don't think so.

Q. You disagree with their testimony, then; is that right? * * *

A. I would certainly say that that was not suggestive.

Q. You would say that the left hand portion of the plaintiffs' exhibit "Y" is not suggestive of the right hand portion?

A. No, sir.

This bit of testimony on the part of Meyers, contradictory of defendants' own expert witnesses on the same question, manifests his *animus* in the whole transaction.

The reason that Meyers chose the Grelle design for the Eugene lamp posts was he believed this design to be original, and he wanted to adopt something for the City of Eugene that was free from patents and he had not been told by Grelle that the latter's design was going to be patented. (Trans., p. 128.) Meyers admitted that when he drew his own modified design he had a photograph of the Grelle lamp post before him. He testified (page 131):

Q. Mr. Meyers, when you made that design for the lamp post, made your own design for the lamp posts, that is these drawings and specifications, is it not a fact that you had Mr. Grelle's photograph, or cut, or whatever it may have been, right alongside of you?

A. I had Mr. Grelle's photograph among the other views and cuts that I had.

Q. *You took a great liking, did you not, to the design of Mr. Grelle's in its general outlines?*

A. Why, I don't know as I took any special great liking to it. *I believe I rather liked the post the first time I saw it.*

Mr. Meyers made a strenuous but futile effort to show that he did not follow the Grelle design. His testimony bearing on this point was (page 132):

Q. Well, do you consider that the design, which you got up from an artistic standpoint, is superior to that which Mr. Grelle got up?

A. Well, I did not consider it so in a way, and yet in another way, too. The design that I got up I made a special effort outside of the artistic standpoint—I suppose perhaps in some people's eyes I destroyed the artistic appearance of the post by trying to make the post exceedingly plain so it would not catch dust, as practically or nearly to the extent that all the other posts would, with their extreme orna-

mentations. Leaving that off, I considered that I had a post that would present a much better appearance during the dusty summer.

Q. Well, is it not a fact, when you took a square surface and knocked off some of the corners, we get it towards the round?

A. I suppose that is true.

Q. Well, when you knock the corners you have less surface, have you not?

A. Well, I suppose you do, but if you leave the corners very rough and jagged, you will have lost the whole thing you are trying to gain.

Q. Well, of course, that part would be merely * * * a detail in finish?

A. Yes.

Q. But you will agree with me that a round surface has less area exposed to the collection of dust than any square surface, has it not?

A. Yes, providing it is round and smooth.

Q. Well, you can make any surface smooth, can you not, if you try?

A. Well, yes.

Mr. Meyers further testified (page 139):

Q. The main differences, that you have been speaking about here, as in your mind, changing defendants' lamp post from that of the plaintiffs' patented lamp post is with reference to the details, the panel work and cross section?

A. The entire appearance of the post, as it appears to the casual observer.

Q. Yes, but your main references are to these details, are they not?

A. Why, the details are largely effective in making up my conclusion.

Yes, sir.

When questioned as to what effect the Grelle design had on his own design, the Grelle design being at the time before him, he testified (page 142):

Q. Well, you had the Grelle design before you at the time?

A. I had the Grelle design as far as the photograph would give me the general appearance.

The witness had previously testified (page 125) that the sketch given him by Mr. Grelle "suggested generally the post as finally designed."

Witness further said (page 142):

"To what extent I may have been influenced by this particular design I could not say. I had it before me, but I did not wish to follow any of the lines that were presented in that design."

The dominant facts of the case are clearly stated in the opinion of the court below. From such opinion appellants quote the following as bearing on the issues raised in this appeal (page 174):

"The plaintiff, Charles Edward Grelle, invented and had patented an ornamental design

for lamp post, the patent bearing date March 12th, 1912, the application therefor was filed in the Patent Office January 2nd preceding. In December prior to such application, the defendant, City of Eugene, let a contract to Gross Brothers of that place for the manufacture of certain lamp posts designed by Alvin Meyers, who was the superintendent of the Water Board of the city." * * *

*It may be further noted that Meyers, in designing the lamp post for the city, had before him a photograph of the Grelle post, which has been designated at trial as type "S," AND ADOPTED some ideas from the type "S" post in working out his own design. Both designs of lamp posts consist of a base, a fluted cylindrical column, diminishing at the top, a shoulder or head from which four arms extend, and a single light with globe at the top. The four arms extend from the head or shoulder at an angle of 45 degrees, more or less, and curve downward at the outer ends, from which the lamps with globes are suspended. * * ** The only question (page 176) which I deem it necessary to pass upon under the view that I take of the case is whether the city's post is an infringement upon the type "S" post. * * * The only parts of the two posts *that bear marked similarity are the columns and the arms in their general longitudinal contour and declination to the shoulders of the post, and even as to these latter,*

the arms on the city's post at the outer extremity drop more abruptly, as has been previously observed, than the type "S" design. The base of the city's post is square, and the cap thereon is square, while the base of the type "S" post is cylindrical and fluted and the cap is round. The cap at the top of the column of the city's post is square, the shoulder is square, and the cap above is square. All these in the type "S" post are round or cylindrical. The arms of the city's post are square and paneled, while those of the type "S" post are cylindrical and fluted.

The plaintiff has introduced *comparative drafts of the mere outlines of the two posts*, which drafts it *must be admitted present great similarity and one cannot be readily distinguished from the other without giving particular attention to detail.* * * * The city's posts run predominantly in square surfaces, while cylindrical surfaces predominate in type "S," features that must catch the eye instantly and distinguish one from the other.

The conclusion of the court was that since (page 178) "the probability that the general purchaser would be misled or deceived in buying one of these posts for the other is very remote," the finding must be for defendants.

The errors assigned by appellants to these conclusions of the court are:

I.

The District Court erred in finding that the lamp post erected and used by defendants in said City of Eugene, Oregon, did not infringe upon the design patents of plaintiffs.

II.

The District Court erred in ruling (as in substance stated in the court's opinion) that while the designs of the plaintiffs' and the defendants' lamp post should be viewed as wholes without special attention to minutiae of detail or ornamentation, and while the outlines of said post present great similarity, and one cannot readily be distinguished from the other without giving particular attention to detail, nevertheless this is not a safe test, because the defendants' post runs predominantly in square surfaces while the cylindrical surfaces prevail in the plaintiffs' post, and therefore the defendants' post is distinguished from, and does not infringe upon the plaintiffs' patented post, and the bill of complaint is without equity and must be dismissed.

III.

The District Court erred in not finding that the defendants' lamp post does infringe the design patent of plaintiffs set forth in the bill of complaint herein.

IV.

The District Court erred in dismissing the bill of complaint herein without granting the plaintiffs any relief.

V.

The District Court erred in not granting to plaintiffs the injunction and the other relief prayed for in their bill of complaint herein.

ARGUMENT AND AUTHORITIES

The presumption of validity which attached to the granting of said patents to C. E. Grelle was not successfully assailed. The only question in the case, as correctly decided by the trial court, was whether the defendants' post infringed said patented design.

The court, in arriving at its conclusions, seems to resolve its doubt against the infringement, notwithstanding the "great similarity" in outline form of the two lamp posts, because in the Grelle lamp post the outline had been worked out in a thing of cylindrical cross section, while in the defendants' lamp post this outline was worked out in a thing of square cross section; and seemed further of the opinion that the test to be applied was whether the *general purchaser would be misled* or deceived in buying one of these posts for the other; and since, in the court's opinion, such result was remote, therefore the defendants' lamp

post did not infringe upon the Grelle patented design.

To the appellants it is quite clear that Meyers, in designing his post, tried to get as close as possible to the Grelle design without making a *Chinese* copy of the latter. And now, when his design is drawn into question, he is prepared to defend it on the same grounds so frequently introduced in unfair competition cases. As stated in one of the leading cases on this subject (*Enterprise Mfg. Co. v. Landers*, 131 Fed. 240, 241):

“Usually in these cases the defendants so dress their goods as to present a number of points of differences on which they rely when charged with intent to deceive, insisting that, although there may be resemblance, the differences are so great as to preclude any idea that they sought to produce confusion, *i. e.*, sought to imitate.”

The reason Meyers adopted the principle of the Grelle lamp post design obviously was this: He wanted to get a lamp post pleasing in form, but not patented. He considered the Grelle design original, so he concluded to imitate this in outline or general form, but to introduce variations in the cross sectional structure and in the surface ornamentation of the form, so that he could also escape any proprietary claims of the design on the part of Grelle.

The trial court was in error in applying to the question of infringement here involved the test, whether there was a probability of deceiving a person desiring to buy a lamp post of the Grelle design by substituting therefor one of the Meyers design. Indeed such deception would be quite possible if we imagine both lamp posts reduced to the size suitable for a table lamp. But this question is not an indispensable factor in any design patent infringement. The question is, has the patented thing been unlawfully appropriated?

In other words, proof of the probability of deception of a purchaser is not an essential ingredient in a suit for infringement of a design patent. There is no such limitation in the law. That is not the doctrine of *Gorham Co. v. White*, 14 Wall. 511. The question of deception has merely been introduced as a convenient rule which helps the solving of disputes concerning articles such as tableware, china, silver, etc.; in short, small articles made in quantities and bought by the general public. But patents for designs are also granted for things not so made and sold; *e. g.*, street lamp posts, usually purchased, as in the case here, by the city through an experienced buyer; frequently by an engineer accustomed to scrutinize the shapes and forms of things. So the construction of the patent statute, covering designs, contended for by appellants is, that *if it is found, by the eye of a person of ordinary intelligence, that the thing in ques-*

tion embodies a design plainly imitating the motive or principle of a patented design, infringement exists, regardless whether any purchaser will be deceived by the imitation or not.

In the Meyers lamp post the general outline of form and principle of the Grelle design is unmistakably and undeniably present. Meyers could not get away from that when he designed his own lamp post, because he had the Grelle design before him, and it was impressed on his mind. All Meyers succeeded in doing was to spoil the artistic features of the Grelle design. To use in substance the words of defendants' expert witness, Mr. Doyle (Trans., p. 96), the Meyers post "looks like a poor imitation of the Grelle post."

Can an infringer of a mechanical patent escape by making a poorly constructed imitation of the patented device? No, because the fact of infringement exists just the same. And there is no difference in this respect as to a poor imitation of a patented design.

The trial court further erred when it adopted as the reasons for its conclusions the fact that the parts made cylindrical in cross section in the Grelle design are made square in the Meyers design, notwithstanding such change still preserved the original outline form. As testified by all the expert witnesses, the cross section was merely a

matter of choice. Witness Hensill for defendants testified (page 90) as above mentioned:

Q. Now, is it not a fact, with a given outline I could say to you, "Mr. Hensill, I want that produced in square, or in octagon, hexagon, or elliptical, and you could design a lamp post to be manufactured from that outline in each case?"

A. Yes.

Witness Doyle, on being questioned as to the similarity of the two lamp posts, said (page 100):

Q. But now to you, in these two outlines, Mr. Doyle, is the one suggestive of the other, in your opinion?

A. *Yes, of course, they look very similar in outline.*

The fact, found by the trial court, that the extremities of the arms of the Meyers lamp post drop a little more abruptly than in the Grelle design is also negligible.

In *Bush & Lane Piano Co. v. Becker Bros.*, 207 Fed. 233, 234, the court said:

"To constitute infringement it is not absolutely essential that the defendants' design for its piano should be a Chinese copy of complainant's."

In *Gorham Co. v. White*, 14 Wall. 511, the Supreme Court said:

“The acts of Congress were intended to give encouragement to the decorative arts. * * *

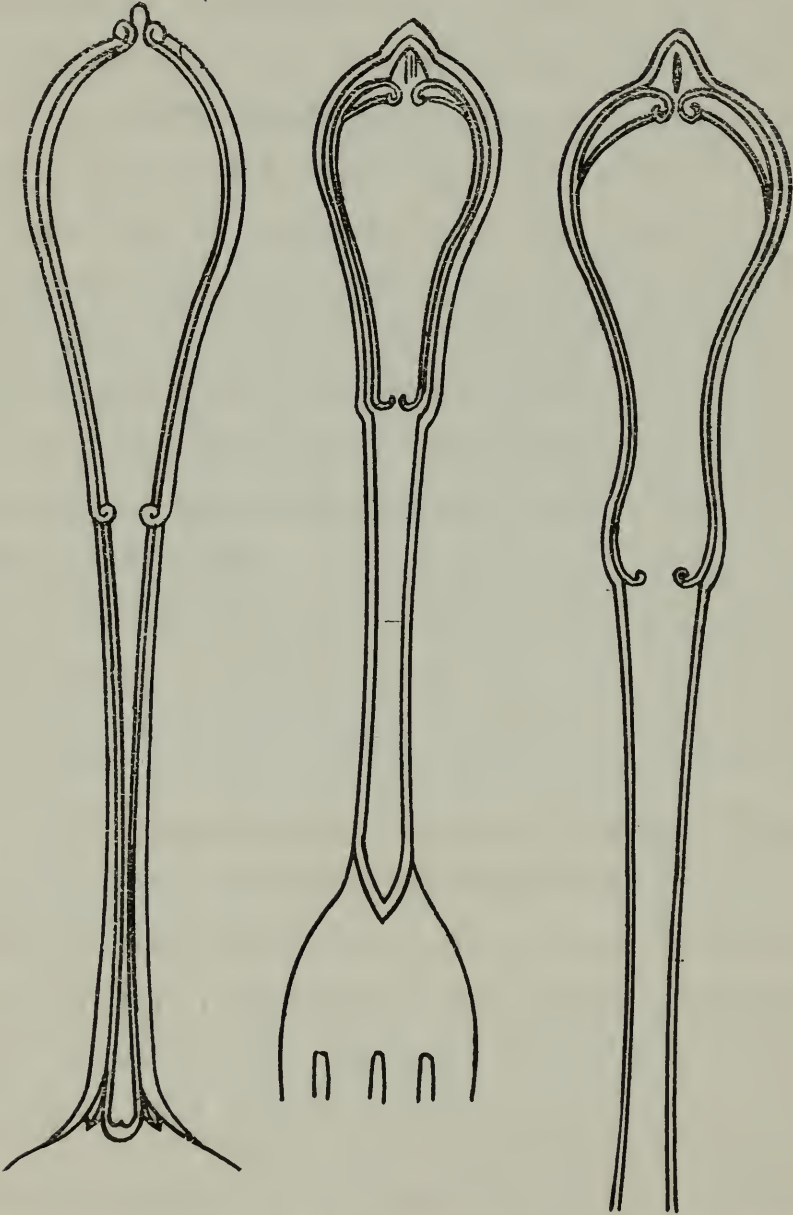
“In determining whether two designs are substantially the same * * * *the controlling consideration is the resultant effect.* * * *

“*All required is substantial identity between the two designs. The purpose of the law must be effected if possible; but plainly it cannot be if, while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced* * * * *are sufficient to relieve an imitating design from condemnation as an infringement.*

“*Though variances in the ornament are discoverable, the question remains, is the effect of the whole design substantially the same?*”

There can be no better exposition of the full meaning of the Supreme Court's conclusions in this leading case than by reproducing here the two designs which such court had before it, and which it determined to be the same *in effect*, though varying in detail from each other, as apparent.

Copy of Cut printed in *Gorham v. White*
as reported in 14 Wall. (81 U.S.) 511, 521.



Gorham Co
(Pat.)

White, 1867.

White, 1868.

The differences discovered by experts in design cases are not received as tests of differences

by the courts. Design cases in this respect differ from cases involving mechanical patents.

Gorham Co. v. White, *supra*.

Appellants will now present their views on the law of design patents, but before doing so, and while the rules and views of the Supreme Court in the case of Gorham v. White are still fresh before us, appellants will again ask the court to view the two designs here in controversy, arranged side by side, as shown in the cut introduction of this brief. And since appellants claim that the particular design patented to Grelle relates to the outline form of lamp post, the court is also requested here to turn back for another glance at the exhibit above reproduced showing the outline forms of the conflicting lamp posts arranged side by side.

What Is The Law Governing Design Patents ?

Quoting in the first instance from Prof. Robinson's Work on Patents, Volume I, page 284, Section 200:

"A design is an instrument created by the imposition upon a physical substance of some peculiar shape or ornamentation which produces a particular impression upon the human eye, and through the eye upon the mind."

Section 201, page 286:

“A design is to be distinguished both from the elements of which it is composed and from the impression which it makes upon the mind of the observer.” * * *

“Each of its elements, when taken by itself, produces an impression on the eye. Combined together, each co-operates with all the others in the creation of a form or decoration which, taken as a whole, makes an impression entirely different from that of either of its separated elements. *The essence of a design*, therefore, resides not in its elements alone, nor in their method of arrangement alone, but in that appearance which results from the co-operation of these elements as they are employed in the design.” * * *

Section 204:

“A design may consist (1) in the simple configuration of a substance or *form given to it as a whole*, or (2) in the ornamentation imposed upon it without reference to its general form, or (3) in such configuration or ornamentation both. Thus *the essential characteristics of the appearance imparted to a substance may reside in its exterior outlines only*.” * * *

Section 206:

“If the idea embraces outline only, no change in decoration will disturb its identity unless the

apparent configuration of the substance be also changed.” * * *

Section 207:

“The unity of a design remains unbroken, notwithstanding any changes in its elements, as long as its essential character as an appearance is preserved.”

The act of February 4th, 1887, covering the infringement of design patents, provides:

“Be it enacted, etc., That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or *any colorable imitation thereof*, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. * * *

“Sec. 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed.” * * *

The other provisions of the statute relating to design patents provide:

“Sec. 4929. Any person who has invented any new, original, and ornamental design for an article of manufacture * * * may upon * * * due proceedings had, the same as in cases of invention or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor.

“Sec. 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the *exclusive right to make, use, and vend the invention* or discovery throughout the United States and the Territories thereof, referring to the specifications for the particulars thereof. A copy of the specifications and drawings shall be annexed to the patent and be a part thereof.”

In one of the first cases ever tried covering a design patent (*Root v. Ball & Davis*, Fed. Cas. No. 12035), the court held that

“To infringe a patent right, it is not necessary that the thing patented shall be adopted in every particular, but if, as in the present case, the designs and figures were substantially adopted by the defendants, they have infringed the plaintiff’s rights. If they adopt the same principal, the defendants are guilty. The prin-

cipal of a machine is that combination of mechanical powers which produce a certain result; and, in a case like the present, where ornaments are used for a stove, it is infringement to adopt the design so as to produce, substantially, the same appearance."

In the Gorham case it was held *not* identity, but *substantial* identity was all that was required to establish infringement or negative novelty.

Will the appellees contend that if Meyers' design had been evolved prior to the Grelle design the latter could have been patented because the claim could be made that the Grelle design was worked out in surfaces having *cylindrical* cross section, or because the extremities of the inclined arms were curved *less* than in the Meyers design?

In a recent case, *McBeth-Evans Glass Co. v. Rosenbaum Co.* (199 Fed. 154-164) the court said, with reference to a lamp shade:

"The principles upon which we may determine this controversy, as to infringement, are the same as those we have referred to for the purpose of determining the validity of the patent, except perhaps as to the use of expert testimony and observation of the manufactured article in use." * * *

If this question cannot be answered in the affirmative, then no more can it be held that the

Meyers design escapes condemnation as an infringement of the Grelle design merely because it has worked out its effect upon surfaces square in cross section, or made the curve at the end of the inclined arms more abrupt than in the Grelle design. For, as is evident, the outline form of the two lamp posts, viewed either from an angle, or from a position directly in front of them, is substantially the same.

In *Tompkinson v. Willets Mfg. Co.*, 23 Fed. 895, the court held:

“In approaching the question of infringement, the rule with reference to design patents should be kept steadily in view. *It is by no means necessary that the thing should be copied in every particular.* If the infringing design has the same general appearance, if the variations are slight, if to the eye of the ordinary person the two are substantially similar, it is enough. It is of no consequence that persons skilled in the art are able to detect differences.”

The principles of the law relating to patented designs are well understood by the courts, but in the application thereof an error is quite likely to occur, unless the application of the principle, involved in a given case, be placed side by side, as it were, with the patented design and the infringing article. This was done in the original

report of the Gorham case, but unfortunately is not generally done in the reports of design cases.

The appellants contend that each case must be considered by itself. That there are three general classes of designs, and the first step to be taken is to ascertain the class to which the particular design belongs: whether, 1, the impression produced by the design is a one of general effect—an outline form, or some other, general characteristic; or, 2, whether merely relating to some particular part of the thing, for example, a particular surface ornamentation; or, 3, whether both the outline-form and the surface ornamentations are to be considered. This statement will be recognized as substantially the rule laid down in *Robinson on Patents*, above quoted.

In the case at bar, we have only to deal with the first class, and a good illustration of what deviations from such a design—that is, one covering a general characteristic—will be disregarded is given in one of the earlier cases, *Wood-Dolby*, 7 Fed. 475. The description of the design there involved and the differences in the alleged infringing article, were clearly stated so as to be available, like the Gorham case, which it followed, as a guide for future adjudications.

The design here in question consisted of the representation of a bird upon a branch or twig, with a leaf above the bird, and a panel at the base of the twig, in white and gold colors, with

a diamond upon the leaf and two diamonds upon the panel. The court said, the defendant's wings *have* "a setting of the same outline as that represented in the orator's patent, representing a bird upon a branch or twig, with a leaf above the bird and a panel or a larger part of the branch in the shape of a panel, and two leaves at the base of the twig, in white or silver or gold colors, and a diamond upon the leaf above. There are two other leaves over the bird in the defendants' setting. The wings of the bird are in a different position from those of the bird in the plaintiff's setting, and the upper leaf is turned differently; but the two leaves below the bird in the defendants' setting are in white or silver color, and somewhat resemble the diamonds upon that part of the plaintiff's, and, all together, more is required than to observe and consider the artistic effect of each to bring these differences to notice. Looked at as ornaments desirable for their beauty or appropriateness according to the taste of the wearer, these differences in the details become immaterial."

In *Bush & Lane Piano Co. v. Becker Bros.*, 209 Fed. 233, the court held, to constitute an infringement of a design patent, it is not essential that defendant's design should be a *Chinese* copy of that patented, but it is sufficient if it imparts to the mind the same *general idea* of appearance.

In *General Gaslight Co. v. Matchless Mfg. Co.*, 129 Fed. 137, the court said: "The shape and

configuration of the lamp in its entirety, the collocations of its mechanical features, the arrangement of the cluster lights, * * * the contour and proportions of the bulbous globe all considered as contributing to design.”

The case of *Hutter v. Broome*, 114 Fed. 655, in a way explained the reason why courts in design cases frequently draw their analogy from the principles applied to cases of unfair competition:

“To determine whether a design infringes a design patent, we cannot look solely to the elements, nor the details in carrying out the parts of the design, but the test, (is) somewhat like that applied in the case of unfair competition” * * *;

and then comment on the fact that the observer “having been pleased with the general appearance” might, nevertheless, fail to be impressed by, or carry away the details of the design.

These observations apply to this case. Meyers was impressed by the motive of the Grelle design. He said:

“Why, at first, as I said before, I rather approved of Mr. Grelle’s design, (trans. p. 133) but as I went further on I did not approve of Mr. Grelle’s design, and went to the other extreme.”

Meyers said that his reason for departing from the Grelle design was, he wanted to produce "a post that would present a much better appearance during the dusty summer" (p. 132). He claimed to have attained this result in converting the cylindrical cross-section of the Grelle post into a square-cross, though he admitted that a round object had less surface than a square one (p. 132). And in fact all he succeeded in doing was to *spoil* the Grelle design. Meyers admitted he could not tell "to what extent he may have been influenced by this particular design" (p. 142). The fact is, *he imitated* this design; but from an artistic point of view he made a poor imitation. This was the verdict of Mr. Doyle, the architect, expert witness called by defendants. He, in characterizing the Meyers post, said, "*it looks like a poor imitation,*" and he had reference to the artistic effect. He said that the plaintiff's post is the best design, from an artistic standpoint, decidedly. (p. 96.)

In *Mygatt v. Zalinski et al.*, 138 Fed. 88, 89, the court said:

Slight changes are made which add nothing to the ornamentation, but *rather detract therefrom*. These, however, enabled the defendants to say, our shade or reflector is different from yours, therefore we do not infringe.

But the court found—

“The defendants are making and selling substantially what the complainant * * * is authorized by his patent to make and sell.

“True, * * * the angle is changed, the edge is curved or beaded and * * * there are other slight changes, *but these changes are evidently made to be used in justifying the infringement, if possible.*” * * *

In *Graff et al. v. Webster*, 195 Fed. 522, 524 (C. C. A., 2d Cir. 1912), the court—after referring to the fact that a number of articles were produced, together with drawings and engravings, each bearing certain features in common with the designs of the patents, but otherwise possessing marked dissimilarities—said: “*There is no reason, therefore, for limiting the patented designs to the identical structure shown and described,*” and followed this remark by quoting from the *Gorham* case: “The purpose of the law must be effected if possible; but plainly cannot be, if while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced * * * are sufficient to relieve an imitating design from condemnation as an infrinment. * * * The differences between the two designs are differences of detail, and not of substance.”

The two cases last cited point well to the conclusions which appellants contend for here. The

Meyers post was a modification of the Grelle design. The change detracted from the latter, and the change was unquestionably introduced by Meyers in order that he might say, as he has said: "Our (lamppost) is different from yours, therefore we do not infringe," applying, for illustration, the language of the court in *Mygatt v. Zalinski, supra*. And the defendants insisted that the Grelle design should be *limited* to the *identical* structure shown and described in the Grelle patent; and since Grelle, for artistic reasons probably, chose the cylindrical form, and Meyers the square, and because Grelle used a graceful curve for the extremities of his arms, while Meyers used an ungainly, abrupt curve—therefore the identity was destroyed and the defendants may escape. To adopt this contention of the defendants would be to disregard the rule on this point in the case of *Graff et al. v. Webster, supra*. In that case the court said: "There is no reason (which may be based on the proofs) for limiting the patented design to the identical structure shown and described." There was no reason shown in the case at bar. The Grelle design, taken as a whole, in its motive and outline-form effect was new. Mr. Doyle said with respect to this design, "They are new combinations * * * that I have never seen before." (p. 99.)

Would it carry out the purpose of the law to impose upon the design of the Grelle patent, the limitation contended for by appellees?

The appellants, in closing their argument, cannot present their position more forcibly than by quoting from the closing paragraph of the Supreme Court's opinion in the Gorham case:

The appellee's contention cannot be sustained, unless design patents of the character here in question are "to receive such construction that the act of Congress will afford no protection to the designer against the imitation of his invention."

The decree of the District Court should be reversed and the appellants granted the relief prayed for in their bill of complaint.

Respectfully submitted,

T. J. GEISLER,
Attorney and Counsel for Appellants.

~~Insert~~ for Appellants' Brief in Cause No. 2456
pending in

**United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT**

BETWEEN CHARLES EDWARD GRELLE and THE INDEPENDENT FOUNDRY COMPANY, a Corporation,
Appellants,

v.

THE CITY OF EUGENE, OREGON, and M. F. GRIGGS,
Appellees.

Pursuant to the permission, given on the argument of this cause, appellants give below the cases which they cited in the trial court on the argument of the question of an alleged implied license, abandonment and estoppel, but omitted from their brief on appeal, because they assumed that the appellees had abandoned this position, in accordance with the views of the trial judge on this question.

The pleadings of the appellees (defendants) on these questions were: Par. IX. of Defendants' further and separate answer; (Trans. p. 42):

“IX.

“That the plaintiffs, by making a competitive bid to furnish the posts designed by said City, and by reason of the premises, licenses and permitted the defendants to manufacture and use said posts for the said street lighting system of defendant City.

“That by reason of the premises the plaintiffs have abandoned their patent and rights thereunder, so far as the same would interfere with

the defendants in installing the lamp post designed by said City.

“That by reason of the premises the plaintiffs are and ought to be estopped from claiming or asserting any rights under said pretended patent that would be in conflict with the right of defendants to manufacture said posts and install the same for said street lighting system of defendant City.”

In *Cayuta Wheel & Foundry Company v. Kennedy Valve Mfg. Company*, 127 Fed. 355, it was held, under a city charter which provided that no patent hydrant, valve or stop cock shall be used by the department of water supply unless the patentee or owner of said patent shall allow its use by said department without royalty, the fact that the owner of a patent for a hydrant made an unsuccessful bid to furnish said hydrants under a contract with the department, does not constitute an *abandonment* of or implied license under his patent.

In *Standard Sanitary Mfg. Co. v. Arrott*, 135 Fed. 750, 756,

“Where an estoppel is relied upon, the facts upon which it is based must be proved with particularity, and nothing can be supplied by inference or intendment.”

“In the absence of expressly proved fraud, there can be no estoppel based upon acts or conduct of the party sought to be estopped, where such conduct is as consistent with honest purpose or with an absence of negligence, as with their opposites.” *Ib.* 757.

Respectfully submitted,

T. J. GEISLER,
Attorney and Counsel for Appellants.